

REMARKS

Claims 22 – 37, 55 and 59 - 80 are pending.

The rejections are addressed below in detail. No new matter is introduced in this amendment. In summary:

- 1) Claims 1 - 23, 31- 35 have been withdrawn;
- 2) the remaining §112 rejection is addressed again below to resolve the Examiner's remaining rejection;
- 3) the other rejection of the claims under §102(e) is addressed below through amendment, traverse and argument.

Paragraph 4-5: Rejection of claims 22, 24, 25, 27, 35 and 37

The rejection under 112 is traversed again based on the following analysis.

First, the Examiner notes that:

4. Regarding claims 22, 24, 25, 27, 35, and 37, the phrase "**and/or**" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). The primary purpose of this requirement of definiteness

Applicant again notes that the use of the phrase "and/or" is extensive is pervasive in patent prosecution across all art classes, and is puzzled by the Examiner's insistence that its use renders a claim indefinite. The use in claim 22 is as follows:

- ...(a) first computer coupled to the network...
 (b) a second computer coupled to the network; and
 (c) a first software routine executing on said first computer **and/or** said second computer....

The claim clearly sets out a "first" computer (limitation (a)) and a "second" computer (limitation (b)). It then sets out a "first software routine" (limitation (c)) which executes on either or both of the first computer and second computer. That is the commonly understood meaning of such phrase, and the specification in fact documents this exact interpretation, namely that the routine can be implemented in both locations (i.e., in some distributed capacity) or in one of (either A, B) the locations. See page 5, ll. 30 – 32, and page 21, ll. 10 – 11:

"...For ease of use, the setup and transfer may be performed by either or both of such devices."

Applicant notes that the MPEP specifically notes that the meaning of terms should be made with reference to their use in the application is filed. MPEP 2173.05. Similarly the test for definiteness under 35 U.S.C. 112, second paragraph, is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). The present use of the phrase "and/or" is well-known in the art, and is consistent again with what is shown in the disclosure.

Finally, Applicant submits that the phrase "and/or" is apparently sufficiently clear that is used extensively in PTO rules and regulations without any loss of clarity or apparent confusion. For example, see:

1) MPEP 1002.02(b) Petitions and Requests Decided by the Office of the Deputy Commissioner for Patent Examination Policy [R-2]

....

*20. Petitions relating to reexamination proceedings **and/or** reissue proceedings...*

*28. Petitions relating to filing **and/or** issuance of divisional reissue applications...*

2) MPEP 715 Swearing Back of Reference

*.... If the affidavit additionally fails to establish either diligence or a subsequent reduction to practice, this form paragraph should be followed by form paragraph 7.62 **and/or** 7.63.*

3) Ironically, the PTO's own official memo providing updated guidance on this standard for indefiniteness uses this same terminology:

*....To assist in understanding the scope of a claim **and/or** meaning of a claim term, applicants may provide definitions of the claim terms in the written description of the specification.*

See

http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/section_112_2nd_09_02_2008.pdf

Applicant submits that it is simply unsupportable to suggest that persons skilled in a sophisticated field of art are unable to understand commonly used language that apparently any applicant, attorney and Examiner are expected to understand. For these reasons Applicant again traverses the rejection of the "and/or" phrase.

Paragraphs 6 – 7 - Rejection of claims 22 - 37 and 55, 59 - 80 in light of Levy

These claims were rejected under the Levy reference, US Publication No. 2002/0052885, but the Examiner now agrees that the disclosure does not show a unique identifier that contains customer information, so he cites § 103 instead of § 102. The Examiner goes on to state that:

“...There (sic) numerous possibilities for constructing a unique (sic), *but none patentably distinct from each other*. The essential aspect is the fact that the ID is unique, whether it is based on content or combination of customer information or another combination of content and hardware serial number.” (emphasis added)

Applicant submits that this logic, taken to its natural conclusion, would result in an absurd situation in which almost nothing is patentable. For example, under the Examiner's argument, all forms of data “compression” are the same, because their essential aspect is that the data take up less space than before. Or, similarly, all forms of data encryption are the same, because their essential aspect is to make the data less decodable.

Yet the Examiner knows that this is not the test, and he provides no objective evidence to support the notion that *no* forms of digital asset identifiers are patentably distinct. To the contrary, the use of particular forms of identifiers can result in certain advantages, just as there are notable differences and advantages in different compression and encryption schemes. Here, as noted in the specification, the use of customer information to create the identifier clearly results in a different type of unique identifier than one that simply identifies the nature of the file content alone. For example by including customer information the invention can plainly track the distribution/source of the asset within and across a network, and more thoroughly and accurately understand the behavior of the system users. None of these considerations are mentioned or suggested by the Levy reference.

In addition, Applicant has amended the claim to note that the digital asset as transferred does not include copy protection. This aspect of the invention, which focuses on simply tracking transfers, and not introducing cumbersome copy prevention schemes, is discussed at length in the disclosure including at page 21, ll. 21 - 26

....In some applications *where security and accounting is not as critical* (or can be remedied by other mechanisms consistent with the present teachings) it is possible that actual separate instantiations of the digital asset might not be required. Instead, *it might be more practical to simply track the point-to-point movement of a digital asset across network* between one or more Customer Network devices 112, and/or Host Server Network Device 110.

Page 25, ll. 14 – 21 similarly discusses the advantages of merely tracking transfers. See also page 30, ll. 21 which contrasts the invention to those which allow copying without accountability. The focus of Levy, like most prior art, is to prevent unauthorized copying using cumbersome DRM procedures.

Accordingly Applicant requests reconsideration of the rejection on this basis.

Dependent claims 22 - 37 should be allowable for at least the same reasons.

Independent claim 55 is similarly amended and should be allowable for similar reasons. Dependent claims 59 - 74 should be allowable for at least the same reasons.

Independent claim 75 is similarly amended and should be allowable for similar reasons. Moreover the Applicant has again amended the claim to indicate how each transfer results in a unique identifier that is embedded within the digital asset. Over time, different versions of the digital asset are created for the transfers, and each version carries a complete transaction record of transfers of prior versions.

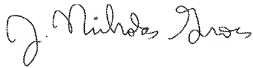
Dependent claims 76 – 80 should be allowable for at least the same reasons. As noted before, Levy does not teach “determining a source of a prior transfer” of an unauthorized version. At best it can apparently only identify the existence of an unauthorized copy.

Conclusion

The rejections and objections from the Examiner have been addressed in detail as noted above. For the reasons set forth above, the undersigned submits that the claims should be confirmed as patentable over the references.

Should the Examiner wish to discuss the present case at any time, please contact the undersigned at any convenient opportunity.

Respectfully submitted,

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